

REMARKS

Claims 1-6 and 10-14 are under examination to the extent that they are drawn to the elected invention, namely polypeptides and pharmaceutical compositions comprising such polypeptides, wherein the polypeptides comprise the amino acid sequence of human S3 (SEQ ID NO: 74).

Specification Amendments:

The specification has been amended, as suggested by the Examiner, to correct typographical and format errors.

No new matter has been added by these amendments. The Examiner is hereby requested to enter these amendments.

Claim Amendments:

Claims 7-9 and 15-33 have been canceled, without prejudice or disclaimer, as drawn to non-elected inventions. Applicants specifically reserve the right to file appropriate continuation and/or divisional applications drawn to the subject matter of these claims.

Claims 1, 2, 5, 10 and 12-14 have been amended to eliminate reference to non-elected subject matter. Claim 1 has also been amended to recite "recombinantly produced or isolated" as suggested by the Examiner. Claims 10 and 12-14 have been amended to correct antecedent bases, due to cancellation of claims or incorrect dependencies.

No new matter has been added by these amendments. The Examiner is hereby requested to enter these amendments.

Information Disclosure Statement:

The Examiner states that no copies of references accompanied the Information Disclosure Statements (IDSs) filed February 25, 2002, April 16, 2002, April 19, 2002 and June 17, 2002. Applicants first note that no June 17, 2002 Information Disclosure Statement was filed for this application. The PTO 1449 bearing a June 17, 2002 U.S.P.T.O. stamp is for U.S. Serial No.

10/003,998. Applicants agree that no reference copies were submitted with the two April IDSs. As noted in each of these IDSs, this is because they were not required under 37 C.F.R. §1.98(d) since they had been cited or submitted in Application Serial No. 09/685,010 to which this application claims priority under 35 U.S.C. §120. Accordingly, copies were not required. As for the references listed in the February 25, 2002 IDS, applicants include a copy of the postcard which indicates that the IDS and copies of 155 references were received by the USPTO on February 25, 2002.

As agreed in a telephone conversation with the Examiner on October 28, 2003, Applicants include herewith copies of the non-US patent references listed in these IDSs for the convenience of the Examiner.¹ The Examiner has agreed to obtain copies of the US patents cited through his own sources.

Consideration of the references and return of Examiner-initialed PTO 1449's are hereby requested.

Objection to the Specification:

The specification has been amended to make the corrections noted by the Examiner.
Withdrawal of the objection is requested.

Rejection Under 35 U.S.C. §101:

The Examiner's rejection of Claim 1 under 35 U.S.C. §101 as drawn to non-statutory subject matter is respectfully traversed. Claim 1 has been amended, as suggested by the Examiner, and is now drawn to recombinantly produced or isolated polypeptides.

Withdrawal of the rejection is requested.

Rejection Under 35 U.S.C. §112:

The Examiner's rejection of Claims 1-6 and 10-14 under 35 U.S.C. §112, second paragraph, as allegedly indefinite is respectfully traversed. The Examiner alleges that the

¹ Applicants will forward a copy of the Altting-Mees reference cited in the April 19, 2002 IDS under separate cover.

recitation of non-elected sequences renders the claims indefinite. The claims have been amended to delete reference to non-elected sequences. Claims 10 and 14 have been amended to delete reference to canceled claim 7.

Withdrawal of the rejection is requested.

Rejections Under 35 U.S.C. §103:

The Examiner's rejection of Claims 1 and 10 under 35 U.S.C. §103(a), as allegedly obvious over Turley et al. A (WO 97/38098) taken with Charo et al. (US Patent No. 5,707,815) is respectfully traversed. The Examiner alleges that the teaching of the full length amino acid sequence of human RHAMM protein in Turley A, without suggestion to use the particular polypeptide fragment of this sequence which is claimed in the present invention, taken with the mere teaching in Charo that leucine may be replaced with isoleucine obviates the present invention.

To properly issue an obvious rejection under 35 U.S.C. §103, the USPTO bears the initial burden of establishing a prima facie case of obviousness by meeting three criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings to arrive at the claimed invention. *In re Vaeck*, 20 USPQ 2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference or the combination of references must teach or suggest all the claim limitations. *In re Royka*, 180 USPQ 580 (CCPA 1974).

The rejection of Claims 1 and 10 does not meet the required criteria. Turley A teaches the use of the full length RHAMM protein, without any indication or suggestion that polypeptide fragments corresponding to the presently claimed polypeptide (i.e., SEQ ID NO: 74) should be used. Charo merely teaches conservative replacement of leucine to isoleucine. Thus, the references, separately or taken together do not obviate the claimed invention.

The Examiner's rejection of Claims 2-6 under 35 U.S.C. §103(a), as allegedly obvious over Turley et al. A (WO 97/38098) taken with Charo et al. (US Patent No. 5,707,815) in view

of Turley et al. B (EP 0 721 012) is respectfully traversed. The Examiner alleges that the teaching of the full length amino acid sequence of human RHAMM protein in Turley A, without suggestion to use the particular polypeptide fragment of this sequence which is claimed in the present invention, taken with the mere teaching in Charo that leucine may be replaced with isoleucine obviates the present invention in view of Turley B, which teaches the pharmaceutical use of the full length RHAMM protein.

As discussed above, the rejection does not meet the required criteria. Turley A teaches the use of the full length RHAMM protein, without any indication or suggestion that polypeptide fragments corresponding to the presently claimed polypeptide (i.e., SEQ ID NO: 74) should be used. Charo merely teaches conservative replacement of leucine to isoleucine. Combining the teaching of Turley B that the full length RHAMM protein may be pharmaceutically useful does not cure the deficiency that the specifically claimed sequence of the present invention is neither taught nor suggested by the cited references. Thus, the references, separately or taken together do not obviate the claimed invention.

Withdrawal of the rejections is requested.

Double Patenting Rejection:

The Examiner's provisional rejection of Claim 1 under the judicially created doctrine of obviousness type double patenting over Claim 34 of co-pending Application Serial No. 09/685,010 is noted. Applicants will consider filing a Terminal Disclaimer to overcome the rejection, should it be appropriate, at a later date.

Applicant : Tony Cruz et al.
Serial No. : 09/978,309
Filed : October 15, 2001
Page : 32 of 32

Attorney's Docket No.: 16602-009001

Conclusions:

For the reasons set forth above, Applicants submit that the claims of this application are patentable. Reconsideration and withdrawal of the Examiner's objections and rejections are respectfully requested. Allowance of the claims of this application at an early date is earnestly solicited.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date:

October 30, 2003

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